

Application Serial No. 10/767,961

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CENTRAL FAX CENTERREMARKS**I. Record of In-Person Interview**

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On May 23, 2007, M. Scott Carey, of Flexplay Technologies, Inc., and the undersigned met with Examiner Davis for an in-person interview. During the interview, we discussed the Examiner's rejections contained in the Office Action mailed on February 22, 2007. With respect to the Examiner's rejection of the Statement Under 37 C.F.R. 3.73(b), Applicant previously submitted a corrected statement indicating it owns the entire interest in the present application. Regarding the Examiner's rejection of Claims 2-6, Applicant proposed that these claims should not be rejected under In re Orita, 550 F.2d 1277, 193 U.S.P.Q. 145 (C.C.P.A. 1977), because these claims originally issued as Claims 2-6 in U.S. Patent No. 6,343,063.

With respect to the Examiner's rejection of Claims 7-34 and 37-59, Applicant proposed that these claims should not be rejected under In re Orita. In re Orita holds that an applicant should not be permitted to claim previously "non-elected" embodiments in reissue prosecution. Applicant suggested the claims that ultimately issued in the original parent application and in the two divisional applications are related to several different embodiments beyond the two that were initially elected during the original prosecution (species IX, Figure 12 and sub-species III, Figure 3). Accordingly, Applicant asserted that Claims 7-34 and 37-59 in the current pending claim set are related to embodiments that were allowed and issued as claims from the original parent application and the two divisional applications.

Finally, in response to the Examiner's concern about the number and variety of different claims in the current pending claim set, Applicant proposed during the interview that a new restriction requirement be entered in the reissue prosecution in accordance with MPEP §§ 1450 and 1451 and that the claims be grouped in a logical format for further prosecution. Examiner Davis said that he would consider Applicant's positions further in connection with this response and no agreement was reached with Examiner Davis during the interview.

**II. Office Action Mailed February 22, 2007**

In the Office Action the Examiner indicated Claim 1 is allowable and rejected Claims 2-34 and 37-59. Applicant thanks the Examiner for the indication of allowable subject matter and for the careful review of this application. Applicant submits no claim amendments at this time and Claims 1-34 and 37-59 remain pending in this application. Applicant respectfully traverses

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the Examiner's positions in the Office Action.

**A. Statement Under 37 C.F.R. 3.73(b)**

The Examiner states that "the reissue oath/declaration filed with this application is defective (see 37 CFR 3.73(b)) because . . . Assignee failed to indicate the extent of ownership interest by either percentage or entire right." Applicant submits that a corrected Statement Under 37 C.F.R. 3.73(b) indicating that Assignee owns the entire right, title, and interest in the application was filed on June 30, 2006. Applicant further submits that another Statement Under 37 C.F.R. 3.73(b) was filed with the Revocation of Power of Attorney with New Power of Attorney filed on May 18, 2007. Accordingly, Applicant submits that this defect has been fully addressed.

**B. Rejection of Claims 2-6**

The Examiner rejected Claims 2-6 under In re Orita. However, Claims 2-6 were allowed with Claim 1 in the original grant of U.S. Patent No. 6,343,063 and, therefore, are not "non-elected" claims that are prohibited under In re Orita. Furthermore, MPEP § 1450 provides:

As stated in 37 CFR 1.176(b), the examiner is not permitted to require restriction among original claims of the patent (i.e., among claims that were in the patent prior to filing the reissue application). Even where the original patent contains claims to different inventions which the examiner considers independent or distinct, and the reissue application claims the same inventions, a restriction requirement would be improper.

(Emphasis in original). Therefore, Applicant submits that Claims 2-6 should be allowed with Claim 1 because these are the claims that were allowed during the original prosecution.

**C. Rejection of Claims 7-34 and 37-61**

The Examiner rejected Claims 7-34 and 37-61 as directed to subject matter that was "non-elected" in responding to the restriction requirements during prosecution of the original parent application and two divisional applications. While the applicant during the original prosecution only initially elected species IX (Figure 12) and sub-species III (Figure 3) when responding to the restriction requirements during the original prosecution, subsequent actions during the original prosecution show that several other embodiments were also elected and

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allowed in the claims that issued from the parent application and the two divisional applications. The following chart provides examples of other embodiments that were elected and allowed as issued claims during the original prosecution.

U.S. Patent No. 6,011,772 Serial No. 08/902,844	U.S. Patent No. 6,343,063 Serial No. 09/421,490 (Reissue Ser. No. 10/767,961)	U.S. Patent No. 6,434,109 Serial No. 09/887,881
2/23/99 - initial election of species IX, Fig. 12	11/10/00 - initial election of species IX, Fig. 12 and sub-species III, Fig. 3	no restriction or election
Issued Claim 4 (originally Claim 11): relates to Fig. 13	Issued Claim 5 (originally Claim 25): relates to Fig. 4	Issued Claim 3 (originally Claim 3) relates to Fig. 6
Issued Claim 5 (originally Claim 16): relates to Fig. 17	Issued Claim 6 (originally Claim 26): relates to Figs. 7, 8, 9, and 10	Issued Claim 4 (originally Claim 4) relates to Figs. 4 and 11

The examples in the preceding chart are merely illustrative and Applicant reserves the right to assert that the claims identified in the chart, as well as other claims in the patents, relate to a variety of the embodiments illustrated in the patents. These examples show that, in addition to species IX (Fig. 12) and sub-species III (Fig. 3), several other embodiments were elected and allowed in the form of issued claims during the original prosecution. Accordingly, Applicant submits that the claims pending in the current claim set are not "non-elected" embodiments as described in In re Orita, but in fact correspond to embodiments in the claims that issued in the three related patents.

Applicant proposes that a restriction requirement be entered in the current application and that the claims be organized into the following groups:

Group I: Claims 1-6 - these claims were allowed in U.S. Patent No. 6,343,063

Group II: Claims 7, 18-47 - these claims generally relate to Fig. 3

Group III: Claims 8-17 - these claims generally relate to Fig. 17

Group IV: Claims 49 and 50 - these claims generally relate to Fig. 6

Group V: Claims 48, 51-61 - these claims are genus claims encompassing the embodiments shown in several figures. Under In re Doyle, 293 F.3d 1355, 63

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U.S.P.Q.2d 1161 (Fed. Cir. 2002), "linking claims" encompassing multiple embodiments are permissible. See MPEP § 1412.01.

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CONCLUSION

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The foregoing is submitted as a full and complete response to the Office Action mailed February 22, 2007. Applicant and the undersigned thank Examiner Davis for considering these remarks. If the Examiner believes that any issues exist that can be resolved by telephone conference, or that any formalities exist that can be corrected by an Examiner's Amendment, please contact the undersigned at (404) 572-3505.

Respectfully submitted,



Robert T. Neufeld  
Reg. No. 48,394

King & Spalding LLP  
34<sup>th</sup> Floor  
1180 Peachtree Street, N.E.  
Atlanta, Georgia 30309-3521  
404.572.4600

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